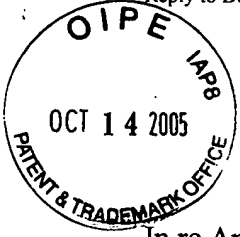


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I/M

Application 08/419,229  
Request for Reconsideration dated October 14, 2005  
Reply to Decision denying Petition to Expunge dated October 6, 2005



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Thrift et al.

Serial No.: 08/419,229

Filed: 04/10/1995

For: Voice Activated HyperMedia Systems Using Grammatical Metadata

Docket No.: TI-20205

Examiner: Dorvil, Richemond

Art Unit: 2654

Confirm. No.: 3703

**REQUEST FOR RECONSIDERATION BY THE COMMISSIONER OF DECISION**

**DENYING PETITION TO EXPUNGE – 37 C.F.R. §1.59(b)**

Mail Stop Petition

Commissioner for Patents

Alexandria, VA 22313-1450

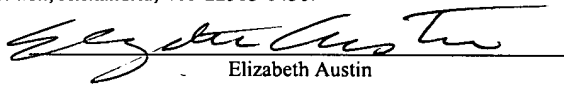
Dear Sir:

**EXPRESS MAILING CERTIFICATE**

Express Mailing Label No.: EY 561330605 US

Date of Deposit: October 14, 2005

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Mail Stop Petition, Alexandria, VA 22313-1450.

  
Elizabeth Austin

Applicants respectfully request reconsideration by the Commissioner of the Decision on Petition dated October 6, 2005 denying Applicants' Petition to Expunge, for the reasons set forth below.

TI-20205

## **PREFACE TO ARGUMENT**

It is initially requested that this Request for Reconsideration be handled by the Commissioner or that a statement be provided in response to any denial of this Request that such denial is a final PTO decision on the issues raised herein to avoid any issue on this point in the event further action in this case is deemed to be appropriate.

## **ARGUMENT**

### **THE PTO HAS EGREGIOUSLY MISREPRESENTED THE FACTS IN THE RECORD IN ORDER TO JUSTIFY ITS DENIAL OF APPLICANTS' PETITION TO EXPUNGE – AS SUCH THE DENIAL MUST BE WITHDRAWN AND THE PETITION GRANTED**

- A) **THERE IS NO SUPPORT IN THE RECORD FOR THE PTO'S DETERMINATION THAT THE BOARD ORDERED THE EXAMINER TO DETERMINE THE PRECISE SCOPE OF THE APPEALED CLAIMS CONSISTENT WITH 35 U.S.C. 112, SIXTH PARAGRAPH, AND IN RE DONALDSON**

The lynchpin of the PTO's argument in denying Applicants' Petition to Expunge dated May 4, 2004 is that the Board of Patent Appeals ORDERED the Examiner to determine the precise scope of the appealed claims consistent with 35 U.S.C. 112, sixth paragraph, and In re Donaldson. Applicants dispute this determination as being a misrepresentation of the facts.

The PTO is required to follow the directions and/or instructions provided by the Board in its Remand to the Examiner. The PTO cannot, as it has in the present case, selectively follow out-of-context portions of the Remand to the Examiner by the Board. The actual determination/directions from the Board to the Examiner in the Remand to the Examiner states:

The above-identified application is hereby remanded to the Examiner for appropriate action **consistent with the decision of the CAFC and our comments below.**

**Should the Examiner, after further consideration, decide that it is appropriate to reopen prosecution** we make the following observations.

As stated in the CAFC decision of August 9, 2002, the court noted that independent claims 11 and 14 differ from independent claim 1, the obviousness rejection of which was upheld by the court, by adding a grammar creation capability to the claimed voice activated Hypermedia system. The court's decision concluded that the Board erred in affirming the obviousness rejection of independent claims 11 and 14 since the Examiner's assertion that "... [t]he use of grammar is old and well known in the art of speech recognition ..." was unsupported by any evidence. Accordingly, **in any FUTURE formulation of AN OBVIOUSNESS rejection of independent claims 11 and 14,** the Examiner is required, as a starting point, to provide clear evidence of the existence in the prior art of grammar creation capability in speech recognition systems. (Remand to the Examiner, page 2, lines 2-22).

In light of the above, the Board clearly left it to the discretion of the Examiner, after further consideration, as to whether or not prosecution should be reopened. Accordingly, the PTO's determination in its Decision on Petition that the Board ordered the Examiner to undertake the action at issue is clearly erroneous and must be rejected. There was no ORDER by the Board to reopen prosecution. The improper attempt by the Examiner to reopen prosecution and reject under section 112 was repudiated by the PTO as being "unfounded" [See Interview Summary dated December 12, 2003 from Mark R. Powell], Director, effectively resulting in a

non-reopening of prosecution, The Director further stated in the Interview Summary that “[u]nless the Examiner has present knowledge of the existence of a particular reference(s) that provides clear and convincing evidence of the unpatentability of the claims at issue, the case shall be passed to issue”. No such reference has ever been cited.

**B) TO THE EXTENT THE BOARD LEFT IT TO THE DISCRETION OF THE EXAMINER TO DETERMINE THE PRECISE SCOPE OF THE APPEALED CLAIMS CONSISTENT WITH 35 U.S.C. 112, SIXTH PARAGRAPH, AND IN RE DONALDSON – IT WAS FOR ANY FUTURE FORMULATION OF AN OBVIOUSNESS REJECTION AND NOT FOR ANY PRESENT OR PAST FORMULATION**

The Board ordered the Examiner, upon reopening prosecution, to determine the precise scope of the appealed claims consistent with 35 U.S.C. § 112, ¶ 6 and In re Donaldson, with respect to any FUTURE formulation of an OBVIOUSNESS rejection of independent claims 11 and 14. The Board did NOT, as incorrectly determined by the PTO in its Decision on Petition, order the Examiner to determine the precise scope of the appealed claims consistent with 35 U.S.C. § 112, ¶ 6 and In re Donaldson, with respect to any PAST OR PRESENT formulations of an OBVIOUSNESS rejection of independent claims 11 and 14. Since there were no PRESENT formulations of an obviousness rejection pending at the time of the Remand from the Board, and the Court of Appeals for the Federal Circuit had vacated the previous or past formulations of an obviousness rejection, it is clear that the Examiner was not ORDERED or authorized by the Board to determine the precise scope of the appealed claims consistent with 35 U.S.C. § 112, ¶ 6 and In re Donaldson under the formulation of the obviousness rejection vacated by the Court of Appeals for the Federal Circuit. As such, his actions were unauthorized by the PTO and ultra

vires. This fact is further corroborated by the above-noted Interview Summary. The Examiner's unauthorized, ultra vires acts must be withdrawn and expunged from the record.

- C) **TO THE EXTENT THE BOARD LEFT IT TO THE DISCRETION OF THE EXAMINER TO DETERMINE THE PRECISE SCOPE OF THE APPEALED CLAIMS CONSISTENT WITH 35 U.S.C. 112, SIXTH PARAGRAPH, AND IN RE DONALDSON – IT WAS ONLY AFTER PROSECUTION WAS REOPENED AS TO AN OBVIOUSNESS REJECTION OF CLAIMS 11 AND 14**

To the extent the Board ordered the Examiner to determine the precise scope of the appealed claims consistent with 35 U.S.C. § 112, ¶ 6 and In re Donaldson, such determination was to be performed AFTER prosecution was re-opened as to an obviousness rejection of claims 11 and 14 – NOT anytime the Examiner wanted in order to “clarify the record”, as determined by the PTO in Denying Applicants Petition to Expunge. The record shows that the Examiner re-opened prosecution in this application after the case was remanded to the Examiner from the Board. The record also shows that under MPEP § 1216.01 (D) the Examiner had no authority to re-open prosecution of his own volition and this fact is corroborated by the above-noted Interview Summary. As such, his action of purportedly placing limitations on the claims is an ultra vires act not authorized by the PTO. The fruit of this improper action must be removed from the record of this application.

- D) **EVEN WERE, ARGUENDO, THE EXAMINER TO HAVE THE RIGHT TO CLARIFY THE RECORD AT ANY TIME PRIOR TO PATENT ISSUANCE, 35 U.S.C. § 112, SIXTH PARAGRAPH, DOES NOT PERMIT THE EXAMINER TO LIMIT CLAIM LANGUAGE TO CORRESPONDING STRUCTURE OR ACTS DESCRIBED IN THE SPECIFICATION AND NOT EQUIVALENTS THEREOF.**

35 U.S.C. §112, sixth paragraph, specifically states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification **and equivalents thereof**.

In the Office communication dated March 23, 2004, the Examiner states: "With regard to independent claims 11 and 14, the claimed elements defined by "means-plus-function" format are construed as being limited to the following corresponding structure or acts described in the specification ...". The Examiner's determination, even were it to be supportable, which it is not, purports to deny Applicants EQUIVALENTS of the corresponding structure or acts described in their specification. Such is NOT permitted by 35 U.S.C. § 112 or case law. Applicants strongly disagree with this action and point out that such improper action by the Examiner is prohibited by MPEP § 1302.14 which states:

Where specific reasons are recorded by the Examiner, care must be taken to ensure that such reasons are accurate, precise, and **do not place unwarranted interpretations, whether broad or narrow, upon the claims.**

Limiting Applicants' claimed elements to corresponding structure or acts described in the specification and subsequently denying Applicants equivalents to their structure or acts described in the specification is an improper narrowing of the claims which must be withdrawn.

Furthermore, in the REMAND from the Board, the Board specifically stated at page 3, lines 9-13 "[w]hen claimed elements are defined by 'means-plus-function' format, they are interpreted as being limited to the corresponding structure described in the specification or the

*equivalents thereof consistent with 35 U.S.C. §112, paragraph 6.*” (underline and italics not in original).

- E) **EVEN WERE, ARGUENDO, THE EXAMINER TO HAVE THE RIGHT TO CLARIFY THE RECORD AT ANY TIME PRIOR TO PATENT ISSUANCE, 35 U.S.C. § 112, SIXTH PARAGRAPH, DOES NOT PERMIT THE EXAMINER TO LIMIT CLAIM ELEMENTS TO CORRESPONDING STRUCTURE OR ACTS DESCRIBED IN THE SPECIFICATION AND NOT EQUIVALENTS THEREOF.**

35 U.S.C. §112, sixth paragraph, specifically states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be **construed to cover** the corresponding structure, material, or acts described in the specification and equivalents thereof.

In the Office communication dated March 23, 2004, the Examiner states: “With regard to independent claims 11 and 14, the claimed elements defined by “means-plus-function” format **are construed as being limited to the following corresponding structure or acts described in the specification ...**”. While the statute allows claims to be **construed to cover** the corresponding structure, material, or acts described in Applicants’ specification, it does NOT provide the Examiner the authority to **construe the claims as being limited to the following corresponding structure or acts described in the specification**. Such is NOT permitted by 35 U.S.C. § 112 or case law. Applicants also point out that such action is further prohibited by MPEP § 1302.14 which states:

Where specific reasons are recorded by the Examiner, care must be taken to ensure that such reasons are accurate, precise, and **do not place unwarranted interpretations, whether broad or narrow, upon the claims.**

Improperly construing the claims may improperly place an unwarranted narrow interpretation upon the claims which is prohibited by MPEP § 1302.14. The Examiner's actions are improper, violate 35 U.S.C. §112, sixth paragraph, and must be withdrawn and expunged from the record.

F) **EVEN WERE, ARGUENDO, MPEP § 1304, EXAMPLE (D) TO PERMIT AN EXAMINER TO PLACE A STATEMENT IN THE REASONS FOR ALLOWANCE IN RESPONSE TO A CASE REMANDED FROM THE BOARD, SUCH AUTHORIZATION DOES NOT PERMIT THE EXAMINER TO PLACE COMMENTS IN THE REASONS FOR ALLOWANCE THAT ARE NOT CONSISTENT WITH THE REASONS PROVIDED BY THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT OR THE BOARD.**

While the Board directed the Examiner, should he decide to reopen prosecution, to determine the precise scope of the appealed claims consistent with 35 U.S.C. 112, sixth paragraph, the Board did NOT direct the Examiner to construe the claims as being limited to corresponding structure or acts described in the specification.

Such is particularly true in the present case where the Examiner's obviousness rejection was vacated and remanded by the Court of Appeals for the Federal Circuit. Nowhere does the Court of Appeals direct the PTO to construe the claims "as being limited to" corresponding structure or acts described in the specification. Nowhere does the Board construe the claims "as being limited to" corresponding structure or acts described in the specification.



Moreover, to the extent MPEP § 1304 authorizes an examiner to place a statement in the reasons for notice of allowance in response to a case remanded from the Board, the reasons should be those provided by the Board (or the Court of Appeals for the Federal Circuit if it has vacated or reversed a decision of the Board) – NOT reasons provided by an Examiner who did not want to allow the application in the first place but whose obviousness rejection was vacated by the Court of Appeals for the Federal Circuit. Any reasons provided by an Examiner in a reasons for notice of allowance subsequent to a remand from the Board where the Examiner's rejection was vacated/reversed, and is not the same as the reasons provided by the Court of Appeals for the Federal Circuit (or Board if reversed by the Board) for the rejection being vacated/reversed, are immediately suspect. Accordingly, the Examiner's actions were ultra vires, not allowed by statute, and a violation of MPEP § 1304 and must be expunged from the record.

**G) MPEP §724.05, 724.02 AND 714.25 ARE NOT RELEVANT TO THE FACTS OF THE PRESENT SITUATION SINCE THESE SECTIONS APPLY TO MATERIALS PLACED INTO THE RECORD BY APPLICANT – NOT THE PRESENT SITUATION WHERE IT IS THE PTO THAT PLACED IMPROPER MATERIAL IN THE RECORD.**

The PTO in its Decision on Petition disingenuously points to MPEP §§ 714.25, 724.02 & 724.05 as providing the types of information eligible for expungement. Applicants respectfully point out that these provisions are not applicable to the facts of the present case since they all deal with an Applicant attempting to expunge materials submitted by Applicant. None of these sections deal with the situation where it is the PTO that places unwarranted materials in a case file. As such, the limitations of above-identified sections have no relevance to the materials requested to be expunged in the present case.

**H) THE PTO'S STATEMENT THAT EXPUNGEMENT TYPICALLY CONCERNS A LINE OR A RELATIVELY-SMALL SECTION OF A PAPER IS NOT RELEVANT TO THE FACTS OF THE PRESENT CASE.**

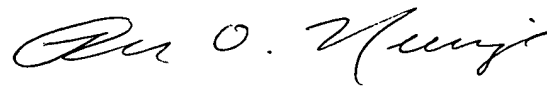
The PTO has pointed to no law or statute that supports its determination that expungement is used only for a line or a relatively small section of a paper. This determination is supposition not supported by fact. Moreover, Applicants point to the language "typically", which indicates that there are exceptions. Applicants respectfully submit the present case to be such an exception. The PTO purports to place undue restrictions on the scope of the claims after prosecution was closed. The actions are unauthorized, are improper, and the entire statement by the Examiner should be expunged.

**I) APPLICANTS' TRAVERSE THE PTO'S IMPLICATION THAT THERE WAS A GENUINE DEBATE BETWEEN THE EXAMINER AND APPLICANTS AS TO HOW § 112, SIXTH PARAGRAPH, WAS TO BE APPLIED IN THIS CASE.**

In its Decision on Petition, the PTO implies that "because there was genuine debate between the Examiner and Applicants on how § 112 applied to this case (September-December 2003), it was reasonable for the Examiner to clarify the record in writing thereafter". Applicants respectfully submit that such statement is disingenuous on the part of the PTO. The facts show that in September-December 2003, there was a genuine debate between the Examiner and Applicants on the legitimacy of a new § 112, first and second, paragraph rejection – NOT a six paragraph issue. Moreover, the rejection was subsequently repudiated by Group Director Powell. Accordingly, at the time the Examiner issued his statement that is at issue, there were NO pending §112 issues – the PTO's premise is supposition not supported by fact.

For the reasons stated above Applicants request: 1) reconsideration of the Decision on Petition dated October 6, 2005 by the Commissioner; 2) the Denial be withdrawn; and 3) the Petition be granted.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ron O. Neerings".

Ronald O. Neerings  
Reg. No. 34,227  
Attorney for Applicants

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